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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,900	07/21/2005	Thomas Walther	231511	6881

23460 7590 03/23/2007  
LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER
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LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/517,900

**Applicant(s)**

WALTHER ET AL.

**Examiner**

Brenda A. Lamb

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/10/04, 12/05/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/05/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 22 that the compressible layer is concentrically arranged on a casing is confusing since claim 13 upon which claim 22 depends recites that the compressible is concentrically arranged to the roll core and is firmly adhered to the roller core and therefore it is unclear as to the relationship of the casing to the roller core and the relationship of the compressible layer to the casing and roller core.

Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 25 depends on cancelled claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-18 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/78468.

The examiner has interpreted that the applicator device set forth in claim 1 is comprised of an applicator roller having structure set forth at lines 4-8 and the relationship of the applicator roller to the printing cylinder is intended end use since applicant in the preamble has claimed the use of the applicator device "for a printing or varnishing machine of a processing machine, the processing machine including a printing cylinder having a cylinder channel".

WO '468 teaches the design an applicator device the applicator device comprising: an applicator roller associated with printing cylinder, the applicator roller comprising: a roller core, a compressible layer of cellular foam material arranged in concentric relation to the roller core and firmly adhered to the roller core, and an elastic

cover layer for carrying a medium to be processed, the elastic cover layer being firmly adhered on the compressible layer. WO '468 applicator device is capable of being used in a processing machine which includes a printing cylinder having a cylinder channel since it teaches every element of the applicator device which includes an applicator roller as set forth in the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus WO '468 teaches every positively claimed element of the apparatus as set forth in claim 13. With respect to claim 14, WO '468 applicator device is capable of being used as a moisture applicator in contact with the printing cylinder since it teaches every element of the applicator device which includes an applicator roller as set forth in the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 15, WO '468 applicator device is capable of being used as a ink-applicator in contact with the printing cylinder since it teaches every element of the applicator device which includes an applicator roller as set forth in the

claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 17, WO '468 applicator device is capable of being used as a varnish-applicator in contact with the printing cylinder since it teaches every element of the applicator device which includes an applicator roller as set forth in the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claims 18 and 21, WO '468 teaches the compressible layer is an open-pore material with the open gas-filled pores providing gas inclusions. With respect to claim 23, WO '468 teaches an adhesive layer which acts as barrier layer is arranged between the roll core and the compressible layer. With respect to claim 16, WO '468 teaches the applicator device includes a plurality of applicator rollers and these rollers are capable of contacting a printing cylinder since it teaches every positively claimed element of the applicator device that a plurality of rollers each having a roller core, a compressible layer of cellular foam material arranged in concentric relation to the roller core and firmly

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adhered to the roller core, and an elastic cover layer for carrying a medium to be processed, the elastic cover layer being firmly adhered on the compressible layer. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus WO '468 teaches every positively claimed element of the apparatus as set forth in claim 16. With respect to claim 22, the adhesive layer 13 on the WO '468 roll core acts as a casing since it covers the circumferential periphery of the roll core. Further, WO '468 teaches that the covering for roller covering 3A which includes a compressible layer and an elastic cover layer is monolithic thereby the recited layers can be pulled on the roller core as a sleeve.

In order to expedite prosecution of the case the examiner has assumed that applicant intended claim 25 to depend on claim 13 and not on cancelled claim 1.

Claims 19-20 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/78468.

WO '468 is applied for the reasons noted above. WO '468 teaches the compressible layer is vulcanized on the roller core and teaches the cover layer is elastomeric. WO '468 teaches that the covering for roller covering 3A which includes a compressible layer and an elastomeric cover layer 10 is monolithic or acts as a single composite unit thereon and therefore the elastomeric cover layer 10 is obviously firmly

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adhered on the compressible layer 12 in order from the above cited layers to acts as a single composite unit. WO '468 fails to teach the elastomeric cover layer 10 is vulcanized. However, it would have been obvious to use as the elastomer in the cover layer of WO '468 applicator roller one that has been vulcanized for the known advantage of vulcanization of known elastomeric materials – increase strength and durability of known elastomers. Note the recitation that the cover layer is adhered to the compressible layer by vulcanization does not structurally further the apparatus or applicator roller since it has been held that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. With respect to claims 19-20, WO '468 fails to teach the compressible layer of the applicator roller includes a closed-pore foam material or the combination of closed and open cells. However, it would have been obvious to modify the WO '468 such that the monolithic composite layer (elements 10,12) having the combination of open and closed foam materials is covered by an additional layer similar to layer 10 for the obvious reason to control the hardness of the applicator roll. With respect to claim 24, it would have been obvious given the modifications of the WO '468 applicator device or applicator roller as discussed above to provide an additional layer of barrier material over the adhesive encased roller core for the obvious advantage of providing better adhesion of the compressible layer to the roller core.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-



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1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday. The examiner can also be reached on alternate Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached on (571) 272-1231. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda A Lamb  
Examiner  
Art Unit 1734